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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,351	07/23/2001	Jeffrey M. Garibaldi	5236-000259	3404

7590 03/09/2004

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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 03/09/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/911,351	
Examiner	GARIBALDI ET AL.	
Kennedy Schaetzle	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 24 November 2003.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 9-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 9-15 is/are allowed.  
6) Claim(s) 16 and 17 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 11-24-03 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: the third line of paragraph 0040 is grammatically awkward; element 28 (pacing leads) in paragraph 0042 and element 116 (lumen) in paragraph 0051 is not shown in the drawings.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hall et al. (Pat. No. 6,292,678).

Hall et al. disclose a method of placing a pacing lead (note col. 7, lines 24-29) including a magnetically responsive body in the heart (note col. 8, lines 21-23), comprising introducing a distal end of a delivery catheter into the patient's vasculature system (see Fig. 15), magnetically navigating the distal end of the delivery catheter to the patient's heart (col. 8, lines 25-27), deploying a pacing lead from the distal end of the catheter (col. 8, lines 27-30), and magnetically navigating the pacing lead to the pacing application site by applying a magnetic field to orient the magnetically responsive body on the pacing lead in the desired direction (col. 8, lines 35-41), advancing the pacing lead in the desired direction (inherent in any method of placing a lead).

Regarding claim 17, the examiner considers any magnetic material to lose responsiveness over time, if given enough time.

***Response to Amendment***

4. The amendment to claim 16 has effectively removed the allowable subject matter indicated in the previous Office Action, and has accordingly been rejected as set forth above.

***Allowable Subject Matter***

5. Claims 9-15 are allowed.

Regarding claim 9, the prior art of record fails to teach a method of placing a pacing lead in the heart comprising magnetically navigating a distal end of a delivery catheter to the patient's heart by extending a guide wire having a magnetically responsive seed thereon, advancing the guide wire in a desired direction relative to the delivery catheter, advancing the delivery catheter over the guide wire, and subsequently magnetically navigating the pacing lead to the pacing application site. There is no suggestion in the Hall et al. reference ('678) for incorporating a magnetically responsive seed on a guide wire. Hall et al. instead employ the elongated magnetic element on the pacing lead. The applicants teach that such a system eliminates the need for the delivery catheter to transmit torque and thus may have a soft and flexible distal section for safe advancement without requiring a stiffening stylet.

Reasons for allowance of claims 10-15 have been provided in the previous Office Action.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3762

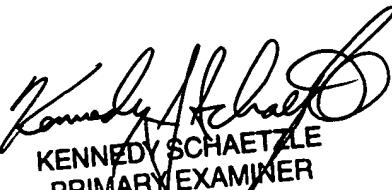
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 703 308-2211. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS  
March 5, 2004

  
KENNEDY SCHAEETZLE  
PRIMARY EXAMINER